



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : **Confirmation No. 8997**  
Peter HEROLD et al. : Attorney Docket No. 2006\_1381A  
Serial No. 10/593,461 : Group Art Unit 1626  
Filed September 19, 2006 : Examiner Rei Tsang Shiao  
ORGANIC COMPOUNDS : **Mail Stop: Amendment**

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**REQUEST FOR NEW OFFICE ACTION**  
**AND**  
**RESETTING DATE FOR RESPONSE**

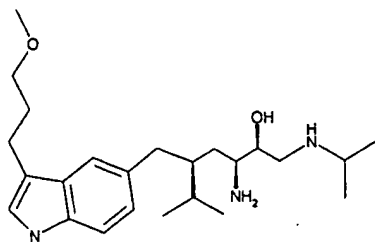
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

THE COMMISSIONER IS AUTHORIZED  
TO CHARGE ANY DEFICIENCY IN THE  
FEE FOR THIS PAPER TO DEPOSIT  
ACCOUNT NO. 23-0975.

Sir:

At the beginning of item 3 on page 2 of the Office Action, the Examiner correctly indicates that Applicants elected the Group III subject matter (as defined in the Office Action of July 29, 2008). However, in the last two paragraphs on page 2, the Examiner's definition of the scope of the invention of the elected subject matter appears to be based on Groups I and II. Referring to item 7 on page 14, the "non-elected subject matter" which the Examiner suggests be deleted from the claims is encompassed by the elected Group III subject matter. Thus, it seems that, based on items 3 and 7, the Examiner did not search/examine the elected subject matter.

In more detail, in response to the restriction requirement Applicants elected Group III, and as a specific species the compound of instant Example 3A (3-amino-1-isopropylamino-5-[3-(3-methoxypropyl)-1-methyl-1H-indol-5-ylmethyl]-6-methylheptan-2-ol):



In the instant Office Action the Examiner acknowledges the election of Group III and the election of Example 3A.


Nevertheless, in the last paragraph of page 2 of the Office Action the Examiner surprisingly **refers wrongly to Group I**. The same conclusion can be based on the content of item 7 on page 14 of the Office Action. The Examiner maybe saw that instant Example 3A contains an indolyl (radical R<sup>6</sup>), however Example 3A does not fulfill the second requirement for Group I, namely that R<sup>1</sup> and R<sup>2</sup> and the nitrogen atom to which they are bonded form a heterocycle ring, piperidine, and therefore Example 3A does fall within Group III.

**Thus, since the Examiner did not search/examine the elected subject matter, Applicants request that a new Office Action, directed to the elected subject matter, be issued.**

**Applicants further request that the date for responding to the Office Action be reset to expire three months from the mailing date of the new Office Action.**

Respectfully submitted,

Peter HEROLD et al.

By:   
 Michael R. Davis  
 Registration No. 25,134  
 Attorney for Applicants

MRD/pth  
 Washington, D.C. 20005-1503  
 Telephone (202) 721-8200  
 Facsimile (202) 721-8250  
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